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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,132	05/29/2001	Knut E. Rasmussen	01-11 US	9635

7590 11/30/2006  
Varian Inc  
3120 Hansen Way M S D 102  
Palo Alto, CA 94304

EXAMINER

VENCI, DAVID J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/857,132

Applicant(s)

RASMUSSEN ET AL.

Examiner

David J. Venci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 18, 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 18, 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action is withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2006, is entered.

Currently, claims 42-47 are under examination.

***Specification***

The disclosure is objected to because of the following informalities. Appropriate correction is required.

Throughout the specification, the recitation of "liquid-liquid-liquid" is indefinite. The identity of three liquid species belonging to "liquid-liquid-liquid" is not clear.

On p. 12, third paragraph, sixth sentence, the recitation of "The hollow fibre" lacks antecedent basis.

On p. 8., third paragraph, fourth sentence, the phrase "The solvent forming the membrane" is indefinite in view of p. 7, lines 3-4, phrase "The membrane acts as a clean-up barrier between two aqueous phases" is indefinite in view of Fig. 3 or Fig. 4. Resolution is required.

Appropriate correction is required.

The amendment filed September 18, 2006, is objected to for the following:

On page 6, the paragraph inserted after "The principles of LLLME will be explained in more detail below", second sentence phrase "the second liquid is the liquid membrane" is indefinite. Examiner is unable to discern the objects referenced by said phrase in either Fig. 3 or Fig. 4.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 42 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the passive voice recitation "equilibrium is established" is not clear. The identity of object(s) and/or step(s), if any, required for performing "establishing" is/are not clear. Whether the objects and/or steps required for "establishing equilibrium" are coextensive with the objects and/or steps required for "stirring" is not clear.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross (US 3,429,785).

Ross describes a method comprising the steps:

(1) providing a first container (see Fig. 6, container comprising test solution 72) having a sample solution (see Fig. 6, test solution 72) comprising a dissolved analyte (see Abstract, "ionic species");

(2) providing a second container (see e.g., Fig. 1, ion sensitive electrode 20) with a membrane wall (see e.g., Fig. 1, membrane 22) having fiber pores (see e.g., col. 5, lines 17-18, "porous polyethylene");

(3) filling the second container with an acceptor solution (see e.g., Fig. 1, ion exchanger liquid 24);

(4) lowering the second container into the first container (see Fig. 6, container comprising ion sensitive electrode 50);

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(5) stirring the sample solution (see col. 8, lines 8-9, "[s]teady state conditions of potential were established");

(6) removing analyte enriched acceptor solution (see col. 8, lines 10-11, "moving the electrode").

***Response to Arguments***

In prior Office Action, claims 42-47 were rejected under 35 U.S.C. 102(b) as being anticipated by Ross (US 3,429,785).

In response, Applicants argue against the existence of "stirring" and "passing of analyte through said membrane wall" (see Applicants' reply, p. 8).

Applicants' arguments are not persuasive.

With respect to "passing of analyte through said membrane wall", Ross describes a "redox process" (see col. 1, line 50) and an "interchange of ions at an interface" (see col. 2, lines 13-14).

With respect to the step of "stirring", Examiner invites Applicants to throw in a stir bar.



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**Conclusion**

No claims are allowed at this time.

This is a continued examination application under 37 CFR 1.114. All claims are drawn to the same invention claimed previously and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**LONG V. LE**

**SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**

David J Venci  
Examiner  
Art Unit 1641

djv